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IN THE

Supreme Court of the United States

OCTOBER TERM, 2002

DESERET BOOK COMPANY; DEAN HUGHES,

Petitioners,

v.

GENE S. JACOBSEN,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Tenth Circuit

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PETITION FOR WRIT OF CERTIORARI

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QUESTION PRESENTED

Whether, for purposes of copyright infringement, a subsequent work is sufficiently "similar" to a copyrighted historical work where the appropriation of expressive elements, if any, is minimal.

STATEMENT PURSUANT TO RULE 29.6

Petitioner Deseret Book Company, Inc., is wholly owned by Deseret Management Corporation, which is the holding company for the commercial enterprises of The Church of Jesus Christ of Latter-day Saints.

TABLE OF CONTENTS

Page

QUESTION PRESENTED i

STATEMENT PURSUANT TO RULE 29.6 ii

TABLE OF AUTHORITIES v

INTRODUCTION 1

OPINIONS BELOW 3

JURISDICTION 3

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS 4

STATEMENT OF THE CASE 5

A. Factual Background 5

B. The District Court Proceedings 6

C. The Court Of Appeals Proceedings 7

REASON FOR GRANTING THE WRIT 9

THE COURT OF APPEALS ERRED BY HOLDING THAT A SUBSEQUENT WORK IS SUFFICIENTLY "SIMILAR" TO A COPYRIGHTED HISTORICAL WORK WHERE THE APPROPRIATION OF EXPRESSIVE ELEMENTS, IF ANY, IS MINIMAL ... 9

A. The Decision Below Is In Tension With Prior Decisions Of This Court 9

B. The Decision Below Conflicts With Decisions Of The Ninth And Other Circuits 13

C. The Question Presented Is A Recurring One Of Exceptional Importance 16

CONCLUSION 18

TABLE OF AUTHORITIES

Page

Cases

Arica Institute, Inc. v. Palmer,
970 F.2d 1067 (2d Cir. 1992) 13

Baker v. Selden,
101 U.S. 99 (1880) 3

Campbell v. Acuff-Rose Music, Inc.,
510 U.S. 569 (1994) 13

Feist Publications, Inc. v. Rural Telephone Service Co.,
499 U.S. 340 (1991) ..... *passim*

Harper & Row, Publishers, Inc. v. Nation Enterprises,
471 U.S. 539 (1985) ..... *passim*

Hoehling v. Universal City Studios, Inc.,
618 F.2d 972 (2d Cir.),
cert. denied, 449 U.S. 841 (1980) ..... *passim*

Mills Music, Inc. v. Snyder,
469 U.S. 153 (1985) 13

Narell v. Freeman,
872 F.2d 907 (9th Cir. 1989) ..... *passim*

Nash v. CBS, Inc.,
899 F.2d 1537 (7th Cir. 1990) 2, 13, 16, 17

New York Times Co. v. Tasini,
533 U.S. 483 (2001) 2, 13

Rokeach v. Avco Embassy Pictures Corp.,
197 U.S.P.Q. 155 (S.D.N.Y. 1978) 11

Rosemont Enterprises, Inc. v. Random House, Inc.,
366 F.2d 303 (2d Cir. 1966),
cert. denied, 385 U.S. 1009 (1967) 2, 15

Russell v. Turnbaugh,
18 U.S.P.Q.2d 1948 (D. Colo. 1991) 3, 11

Sony Corp. of America v. Universal City Studios, Inc.,
464 U.S. 417 (1984) 13

Suid v. Newsweek Magazine,
503 F. Supp. 146, 148 (D.D.C. 1980) 11

Constitutions, Statutes, and Rules

17 U.S.C. § 102 ..... 1, 4, 9, 17

28 U.S.C. § 1254 3

S. Ct. R. 10 9

Secondary Materials

Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 Colum. L. Rev. 1865 (1990) 12

M. Nimmer & D. Nimmer, Copyright (2000) 13

INTRODUCTION

In two pathmarking decisions, this Court has provided lower courts much-needed guidance on important and recurring issues of copyright law. In *Harper & Row, Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), the Court set out the factors to be taken into account in determining whether copying of otherwise protected material constitutes "fair use." *See id.* at 560-69. Six years later, in *Feist Publications, Inc. v. Rural Telephone Service Co.*, 499 U.S. 340 (1991), the Court held that a compilation containing only factual material was not entitled to copyright protection where the factual material was not selected, coordinated or arranged in an original manner. *See id.* at 361-64.

Now, a decade later, this case presents another issue that richly warrants this Court's attention. At stake is a fundamental and sensitive question in our system of free expression—the use of facts and ideas. As the Court noted in *Harper & Row*, "[e]specially in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's original contributions to form protected expression." 471 U.S. at 548. The difficulty arises because facts and ideas are not entitled to copyright protection, *see* 17 U.S.C. § 102(b), whereas "expressive" aspects of an author's work do enjoy such protection, *see Harper & Row*, 471 U.S. at 547. Necessarily, therefore, "the fact/expression dichotomy limits severely the scope of protection in fact-based works." *Feist*, 499 U.S. at 350. This Court has not had occasion to speak, however, on the pivotal task of how courts should go about determining what elements in a copyrighted work are protectible, nor determining whether a copyrighted, fact-based work is sufficiently similar to an allegedly copying work for infringement to have occurred. It is in this day-to-day world of burgeoning copyright litigation that this Court's guidance is necessary.

This case squarely presents these closely related questions. The Tenth Circuit allowed a claim of copyright infringement to proceed against petitioners, an author (prominent novelist Dean Hughes) and

publisher (Deseret Book Company), for incorporating factual anecdotes from a copyrighted autobiographical memoir into a fictional work. The court did so despite the fact that it did not find that petitioners copied any of the exact words of the copyrighted work, save for a single brief passage (which itself was not even reproduced verbatim). That passage consists only of a 44-word quotation from a third party, which the copyrighted work itself merely reported. *See* App. 12a-13a.

The Tenth Circuit's decision is in conflict with the decisions of other circuits, which have allowed minimal verbatim copying of language when an author is copying facts from a historical, factual work. Most notably, in *Narell v. Freeman*, 872 F.2d 907 (1989), the Ninth Circuit expressly permitted the copying of occasional phrases from a historical work. Other circuits have reached similar conclusions. *See Nash v. CBS, Inc.*, 899 F.2d 1537 (7th Cir. 1990); *Hoehling v. Universal City Studios, Inc.*, 618 F.2d 972, 974 (2d Cir.), *cert. denied*, 449 U.S. 841 (1980); *Rosemont Enterprises, Inc. v. Random House, Inc.*, 366 F.2d 303 (2d Cir. 1966), *cert. denied*, 385 U.S. 1009 (1967).

Certiorari is warranted for two additional reasons. *First*, uniformity among the circuits is particularly important in an area of the law such as copyright, in which the decision of one circuit can effectively force a publisher to alter its practices nationwide. In light of this reality, the Court has granted *certiorari* on important issues of copyright law even when there is no split in the circuits. *See, e.g., New York Times Co. v. Tasini*, 533 U.S. 483 (2001). Indeed, there was no split in either *Harper & Row* or *Feist*.

Second, the Tenth Circuit's decision will have significant practical implications, not only for novelists such as petitioner Hughes and publishers such as petitioner Deseret Book, but also for historians, moviemakers, and the broadcast media, who frequently produce works based on previously reported factual incidents. *See, e.g., Nash*, 899 F.2d at 1538-39 (episode of

television series based on historical book); *Hoehling*, 618 F.2d at 975-76 (movie based on historical book). It will also have implications for the news media, who routinely repackage news stories taken from other sources. *See, e.g., Russell v. Turnbaugh*, 18 U.S.P.Q.2d 1948, 1951-52 (D. Colo. 1991) (newspaper stories closely paraphrased from other newspaper stories).

More than a century ago, this Court observed: "The very object of publishing a book on science or the useful arts is to communicate to the world the useful knowledge which it contains. But this object would be frustrated if the knowledge could not be used without incurring the guilt of piracy of the book." *Baker v. Selden*, 101 U.S. 99, 103 (1880). Under the Tenth Circuit's decision, authors can now be held liable for copyright infringement if the factual details of their work too closely resemble the factual details of a previous work—even if the facts are retold almost entirely in the authors' own words. Because the Tenth Circuit's decision promises to have substantial chilling effects on our system of free expression, *certiorari* should be granted.

OPINIONS BELOW

The Tenth Circuit's opinion is reported at 287 F.3d 936 and reprinted in the Appendix ("App.") at 1a-27a. The unreported order denying the petition for rehearing *en banc* is reprinted at App. 28a-29a. The district court's unpublished order granting the motion to dismiss is reprinted at App. 30a-39a.

JURISDICTION

The Tenth Circuit entered judgment on April 19, 2002. Petitioners timely filed a petition for rehearing *en banc*, which was denied on June 24, 2002. This Court has jurisdiction pursuant to 28 U.S.C. § 1254(1).

PERTINENT CONSTITUTIONAL AND STATUTORY PROVISIONS

Section 102 of the Copyright Act, 17 U.S.C. § 102, states as follows:

> (a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:
>
> (1) literary works;
>
> (2) musical works, including any accompanying words;
>
> (3) dramatic works, including any accompanying music;
>
> (4) pantomimes and choreographic works;
>
> (5) pictorial, graphic, and sculptural works;
>
> (6) motion pictures and other audiovisual works;
>
> (7) sound recordings; and
>
> (8) architectural works.
>
> (b) In no case does copyright protection for an original work of authorship extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work.

STATEMENT OF THE CASE

A. Factual Background

Respondent Gene S. Jacobsen was a prisoner of war in the Philippines and Japan during World War II. *See* App. 1a. After returning from the war, Jacobsen wrote a personal memoir entitled *Who Refused to Die*. *See id.* That memoir is a personal account of Jacobsen's experiences in the Bataan Death March and as a prisoner of war. *See id.* at 31a. Jacobsen has testified that the memoir is entirely factual. *See* C.A. Appellants' App. 10, 12, 264, 316, 809; C.A. Appellees' Supp. App. 36. Jacobsen was unable to get his memoir published, *see* App. 32a, and instead distributed unpublished copies of the manuscript informally to family and friends, *see id.* at 31a.

Petitioner Dean Hughes authored, and Petitioner Deseret Book Company published, a five-volume fictional series entitled *Children of the Promise*. *See id.* at 2a. The series was written primarily for members of The Church of Jesus Christ of Latter-day Saints. *See id.* It tells the story of a fictional Latter-day Saints family's life during World War II. *See id.*

Hughes originally entered into an agreement with Deseret Book in 1994 to produce *Children of the Promise*. *See id.* at 31a. Hughes was given a copy of Jacobsen's memoir by Jacobsen's son, who worked with Hughes' wife. *See id.* Upon reading the memoir, Hughes decided that Jacobsen's story would make a good plot line for *Children of the Promise*. *See id.* To that end, he met with Jacobsen on multiple occasions to discuss his experiences. *See id.* at 37a. Hughes based the story of Wally Thomas, one of the fictional family's sons, closely on Jacobsen's real-life story. *See id.* at 2a.

In 1996, Hughes sent Jacobsen excerpts from the first volume of the series, together with a letter stating, "I don't want to do anything you wouldn't feel good about, so let me know if anything is either wrong or somehow troubles you." *Id.* at 37a. Jacobsen

responded with a letter stating that he had read the material and looked forward to the finished product. *See id.* Hughes formally dedicated the second volume of the series to Jacobsen. *See id.* at 32a.

Children of the Promise enjoyed significant commercial success. In 1999, after four volumes of the series had been published, Jacobsen brought suit, claiming copyright infringement. *See id.* Jacobsen only registered his copyright once he had already brought suit. *See id.* at 31a.

B. The District Court Proceedings

After a year of litigation, petitioners moved to dismiss on the pleadings, on the ground that Jacobsen's complaint alleged that Hughes copied only "events, sequences of events, and characters," rather than protected expression. *Id.* at 33a. After carefully reviewing the works at issue, the district court dismissed the complaint. *See id.* at 30a-39a.[1]

The district court noted that Hughes did not copy "precise words" used by Jacobsen, but rather, at most, occasionally used "individual phrases" found in Jacobsen's manuscript, which, the court concluded, were "not original nor distinctive." *Id.* at 34a. The court reasoned that "it is clear that Mr. Hughes copied some 'facts' from Mr. Jacobsen's memoir, but not significant original expression." *Id.* at 36a. The court expressly compared this case to the Ninth Circuit's decision in *Narell v. Freeman*, and concluded that here, as in *Narell*, the allegedly infringing author appropriated only historical research, not significant original expression. *See id.*

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[1] In the alternative, the district court granted summary judgment on the affirmative defense of laches. *See id.* at 37a-38a.

C. The Court Of Appeals Proceedings

The Tenth Circuit reversed. *See id.* at 1a-27a. The court acknowledged that "[t]he difficulty in this case arises in determining whether Dr. Hughes copied only unprotected facts or instead impermissibly copied Dr. Jacobsen's original expression." *Id.* at 5a. Citing Nimmer's treatise on copyright law, the court conceded that the measure of how substantially similar the two works must be for infringement to occur varies according to the circumstances, with more similarity required when less protectible subject matter is at issue. *See id.* at 7a.

With those background principles, the Tenth Circuit then engaged in its own comparison of the Jacobsen and Hughes works. *See id.* at 10a-16a. The court asserted that Hughes copied "much of the plot line for Wally Thomas" from Jacobsen's memoir. *Id.* at 10a. After cataloging several anecdotes that appear in both works, the court asserted that "[i]n some instances, the copying goes beyond close paraphrasing and reproduces Dr. Jacobsen's words exactly." *Id.* at 12a.

Despite its statement that there were "some instances" of verbatim copying, however, the Tenth Circuit cited only one, involving Jacobsen's description of his journey to unite with American troops after the war ended. *See id.* at 12a-13a. The court quoted the relevant passage from Hughes' work, italicizing words that are identical in the two works:

> This time it was Potts who walked on ahead. He was carrying a souvenir sword of his own. When he stepped onto the deck, he shouted, "We need to talk," and he slammed his sword into the deck, sticking it up by its point. * * * "*Listen* to me *you guys*," Potts went on. "*General* Douglas *MacArthur* has authorized us *to use any means* we find *necessary* to reach American troops. *We*'re *going to* cross *this bay with you or without you. If you want to take us*

> *across and get paid for your troubles, fine. If you don't, get off the ship, and we'll take* her across ourselves."

Id. at 13a.

The Tenth Circuit then rejected the district court's comparison of this case to *Narell*. It reasoned that *Narell* "involved verbatim copying of only a few words and phrases," whereas in this case, "the above cited example * * * reveals Dr. Hughes and Deseret Book *arguably* copied more than a few words and phrases." *Id.* at 13a-14a (emphasis added). The court also rejected the argument that the quoted language was not even protectible. *See id.* at 14a. It hypothesized that "Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story," and therefore that the quoted language may have constituted original expression rather than fact. *Id.* The court added that, because Hughes' work contained enough material for a trier of fact to find verbatim copying, it was not necessary to address whether any paraphrasing by Hughes, absent verbatim copying, could give rise to a copyright violation. *See id.* at 15a.[2]

The Tenth Circuit denied rehearing *en banc*. *See id.* at 28a-29a. On remand, the district court stayed proceedings pending the filing of this petition.

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[2] The Tenth Circuit also reversed the district court's decision to grant summary judgment on the affirmative defense of laches, and reversed an evidentiary ruling. *See id.* at 16a-27a.

REASON FOR GRANTING THE WRIT

THE COURT OF APPEALS ERRED BY HOLDING THAT A SUBSEQUENT WORK IS SUFFICIENTLY "SIMILAR" TO A COPYRIGHTED HISTORICAL WORK WHERE THE APPROPRIATION OF EXPRESSIVE ELEMENTS, IF ANY, IS MINIMAL.

This Court should grant *certiorari* because the decision below is in tension with this Court's prior decisions in *Harper & Row* and *Feist* and conflicts with decisions of other courts of appeals, and because the petition presents a recurring question of exceptional importance. *See* S. Ct. R. 10.

A. The Decision Below Is In Tension With Prior Decisions Of This Court.

The Tenth Circuit's decision is inconsistent with the general framework set out by this Court in *Harper & Row* and *Feist* for assessing the similarity of copyrighted and allegedly infringing works.

In *Harper & Row*, the political magazine The Nation published an article drawing heavily from the unpublished memoirs of President Ford. For purposes of its analysis, the Court summarily concluded that the memoirs were copyrighted and that The Nation copied sufficient protected material to otherwise give rise to copyright infringement. *See Harper & Row*, 471 U.S. at 548-49. The Court therefore devoted most of its opinion to the question whether the use of quotations from the unpublished manuscript of a public figure constituted "fair use" under the relevant provision of the Copyright Revision Act of 1976. *See id.* at 549-69.

Before turning to that question, however, the Court did briefly lay out the underlying principles for determining whether a work contains copyrightable material in the first place. Writing for the Court, Justice O'Connor first recognized that § 102 of the Copyright Act, 17 U.S.C. § 102, bars any author from copyrighting

facts or ideas, *see Harper & Row*, 471 U.S. at 547. Instead, the Court noted, "[t]he copyright is limited to those aspects of the work—termed 'expression'—that display the stamp of the author's originality." *Id.* Although the Court recognized that "[c]reation of a nonfiction work, even a compilation of pure fact, entails originality," it quickly added that "copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original * * * as long as such use does not unfairly appropriate the author's original contributions." *Id.* at 548. And notably, the Court acknowledged that, "[e]specially in the realm of factual narrative, the law is currently unsettled regarding the ways in which uncopyrightable elements combine with the author's original contributions to form protected expression." *Id.*

Justice Brennan dissented. Unlike the majority, Justice Brennan addressed at length the threshold question of copyrightability. *See Harper & Row*, 471 U.S. at 580-87 (dissenting opinion). Crucially, the majority did not take issue with Justice Brennan's analysis in this respect. Justice Brennan ultimately concluded that, although the verbatim copying at issue constituted copyright infringement, the paraphrasing did not. *See id.* at 587.

Like the Court, Justice Brennan began by recognizing that facts and ideas could not be copyrighted—and added that such a rule was required to protect First Amendment values. *See id.* at 582. As a result, therefore, "infringement of copyright must be based on a taking of literary form, as opposed to the ideas or information contained in a copyrighted work." *Id.*

Justice Brennan then proceeded to compare the language and structure of the two works in order to determine whether they were substantially similar. As to language, he reasoned that mere "linguistic similarities" between the two works, without more, were insufficient to constitute infringement. *Id.* at 585. He based that conclusion on the fact that much of what The Nation paraphrased

was quoted material, and "[n]o copyright can be asserted in the verbatim representation of [the] statements of others." *Id.* at 586 n.10.[3] But he also noted that "[a]t most The Nation paraphrased disparate isolated sentences from the original," and that such disparate paraphrasing was insufficient to give rise to infringement. *Id.* at 586. As to structure, Justice Brennan reasoned that, to the extent that The Nation's article tracked the order of events recounted in the Ford memoir, an author who presents historical facts chronologically cannot claim infringement when a subsequent author does so as well, even if the subsequent author includes only those facts that the first author selected for presentation. *See id.* at 586-87 & n.12.

In *Feist*, the Court considered whether a white pages telephone directory was entitled to copyright protection, and held that it was not. Again writing for the Court, Justice O'Connor began, as in *Harper & Row*, by emphasizing that "facts are not copyrightable." *See Feist*, 499 U.S. at 344. The Court recognized that factual *compilations* could be copyrighted, but only to the extent that they have original components. *See id.* at 348-49. The Court reasoned that, absent the addition of original *expression* to the underlying facts, a factual compilation such as a directory could be protected only to the extent that the facts are selected, coordinated or arranged in an original manner. *See id.* Notably, the Court appeared to suggest that, in the context of a factual work, only verbatim copying of original expression could give rise to copyright infringement. *See id.* at 348 ("Others may copy the underlying facts from the publication, but not the precise words used to present them.").

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[3] Lower courts have uniformly concluded that a quoting author may not assert copyright over material quoted from others. *See, e.g., Russell v. Turnbaugh*, 18 U.S.P.Q.2d 1948, 1951 (D. Colo. 1991); *Suid v. Newsweek Magazine*, 503 F. Supp. 146, 148 (D.D.C. 1980); *Rokeach v. Avco Embassy Pictures Corp.*, 197 U.S.P.Q. 155, 161 (S.D.N.Y. 1978).

The Court freely acknowledged that "[t]his inevitably means that the copyright in a factual compilation is thin." *See id.* at 349. Quoting Professor Ginsburg's influential article on the scope of copyright protection, the Court reasoned that, "[n]o matter how much original authorship the work displays, the facts and ideas it exposes are free for the taking." *Id.* (quoting Ginsburg, Creation and Commercial Value: Copyright Protection of Works of Information, 90 Colum. L. Rev. 1865, 1868 (1990)). The Court asserted that the so-called "fact/expression dichotomy" was "neither unfair nor unfortunate," even though it "limits severely the scope of protection in fact-based works." *Id.* at 350. Applying these principles, the Court ultimately concluded that the white pages at issue were not entitled to copyright protection because they lacked any original components. *See id.* at 364.

Remarkably, notwithstanding this Court's decisions in *Harper & Row* and *Feist*, the Tenth Circuit made no threshold effort to identify which components of Jacobsen's memoir constituted unprotected fact, and which constituted protected expression. Indeed, the court explicitly refused to "abstract" the unprotected ideas from the protected expression. *See* App. 6a n.5. Instead, the court simply searched the two works for examples of verbatim copying, with scant regard for whether the relevant passage in the copyrighted work contained original expression. And as to the single passage as to which verbatim copying was identified, the Tenth Circuit stated only that the passage *might* contain original expression, on the hypothesis that "Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story." App. 14a. That hypothesis, however, was plainly belied by Jacobsen's repeated assertions that the memoir is entirely factual. *See* C.A.

Appellants' App. 10, 12, 264, 316, 809; C.A. Appellees' Supp. App. 36.[4]

In sum, the Tenth Circuit's failure to identify any protected passages in Jacobsen's memoir is inconsistent with the analytical framework of *Harper & Row* and *Feist*. At a minimum, the Court should grant *certiorari* to resolve the uncertainty it identified in *Harper & Row* regarding the application of this analytic framework in the area of historical, factual works.

B. The Decision Below Conflicts With Decisions Of The Ninth And Other Circuits.

As a threshold matter, it is worth again noting that this Court has frequently granted *certiorari* on important issues of copyright law even where there is no direct circuit conflict. *See, e.g., Tasini*, 533 U.S. at 483; *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994); *Feist*, 499 U.S. at 340; *Harper & Row*, 471 U.S. at 539; *Mills Music, Inc. v. Snyder*, 469 U.S. 153 (1985); *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984).

Here, however, there is a direct conflict, and this Court's review is thus all the more urgent. Specifically, by allowing a copyright-infringement claim involving a historical, factual work to proceed where the appropriation of expressive elements (if any) is incidental, the Tenth Circuit put itself squarely into conflict with the Ninth Circuit's decision in *Narell*, and also into conflict with decisions from the Second and Seventh Circuits.

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[4] In so hypothesizing, the Tenth Circuit unwittingly abrogated the doctrine of copyright estoppel, under which "one who represents his work to be completely factual may not in a subsequent infringement action prove that part of the work was fictional and therefore protectible." 1 M. Nimmer & D. Nimmer, Copyright § 2.11[C], at 2-172.20 to 2.172.21 (2000). To the extent that the Tenth Circuit's decision can be read to repudiate the doctrine of copyright estoppel, it is in tension with the decisions of at least two other circuits. *See Arica Institute, Inc. v. Palmer*, 970 F.2d 1067, 1075 (2d Cir. 1992); *Nash v. CBS, Inc.*, 899 F.2d 1537, 1540 (7th Cir. 1990).

In *Narell*, the Ninth Circuit considered a strikingly similar claim that a fictional work about the heir of a wealthy Jewish family infringed on a historical book on the activities of Jewish families in California. *See* 872 F.2d at 909. The Ninth Circuit affirmed the district court's decision to grant summary judgment to the defendants. *See id.* at 915. Specifically, the court concluded that the allegedly infringing author, Cynthia Freeman, copied no protected expression from the copyrighted work. *See id.* at 912.

The court began by noting that "[h]istorical facts and theories may be quoted, as long as the defendant does not bodily appropriate the expression of the plaintiff." *Id.* at 910-11 (internal quotation omitted). The court conceded that Freeman copied a number of phrases from the copyrighted work, including "rekindle old memories," "staggering network," "river wound its way between muddy banks crawling with alligators," and "hordes of gold seekers." *Id.* at 911. The court reasoned, however, that most of these phrases were commonly used expressions. *See id.* And the court further noted that, to the extent that Freeman paraphrased other elements of the copyrighted work, those elements were mere factual details and therefore not protected either.

By way of an example, the Ninth Circuit cited Longfellow's poem about the ride of Paul Revere. *See id.* at 912. The court noted that "direct copying" of some or all of the famous opening stanza could constitute infringement, assuming that the original held a valid copyright registration. *Id.* The court, however, distinguished copying of "the equivalent of a unique line or stanza" from merely "duplicat[ing] a few ordinary phrases and paraphras[ing] largely factual statements in creating a different kind of story." *Id.* Because Freeman did only the latter, the Ninth Circuit reasoned that "[a] reasonable juror could not conclude that Freeman copied protected expression" from the copyrighted work. *Id.*

The present case is indistinguishable from *Narell*. Here, Hughes at most copied isolated phrases from Jacobsen's work: indeed, in

the single example cited by the Tenth Circuit, Hughes did not copy the entire quotation, but instead only copied such commonplace phrases as "use any means," "get paid for your troubles," and "get off the ship." App. 13a. The Tenth Circuit's attempt to distinguish *Narell* by asserting that "the above cited example * * * reveals Dr. Hughes and Deseret Book *arguably* copied more than a few words and phrases," *id.* at 14a (emphasis added), is therefore entirely unpersuasive. The Tenth Circuit's decision is in direct conflict with *Narell*.

The Tenth Circuit's decision is also in conflict with the decisions of the Second and Seventh Circuits, which took similar methodological approaches to the Ninth Circuit. In *Rosemont Enterprises*, the Second Circuit considered whether a biography of Howard Hughes infringed on copyrighted magazine articles on the same subject. The court recognized that the book copied two direct quotations and one eight-line paraphrase from the articles. *See* 366 F.2d at 306. The court reasoned, however, that there was considerable doubt as to whether the quoted and paraphrased material constituted a substantial part either of the articles or of the biography. *See id.* The court therefore concluded that, although the biography relied heavily on the articles, there was insufficient evidence of infringement to warrant the entry of a preliminary injunction. *See id.*

In *Hoehling*, the Second Circuit affirmed the entry of summary judgment for Universal Studios and an author on a claim that their book and movie about the Hindenberg infringed on a previous book about the same. *See* 618 F.2d at 979-80. The court began by noting that, "absent wholesale usurpation of another's expression, claims of copyright infringement where works of history are at issue are rarely successful." *Id.* at 974. The court added that "the scope of copyright in historical accounts is narrow indeed, embracing no more than the author's original expression of particular facts and theories already in the public domain." *Id.* Accordingly, the court rejected the copyright holder's claim that his copyright was infringed

because the allegedly infringing works copied the basic plot of his book, specific facts, and (most notably for purposes of this case) "random duplications of phrases and sequences of events." *Id.* at 979.

Finally, in *Nash*, the Seventh Circuit similarly affirmed a grant of summary judgment to CBS and other defendants in a case involving a television program that allegedly infringed on four historical books written by the same author, Jay Robert Nash, in which he laid out his own unique theory about the fate of the gangster John Dillinger. *See* 899 F.2d at 1539. Judge Easterbrook, writing for the court, reasoned that, "[i]f Nash had written a novel that another had translated into a screenplay, this would be a difficult case." *Id.* at 1541. The fact, however, that "Nash does not portray [his books] as fiction * * * makes all the difference." *Id.* The court noted that the television producers used the books merely "as a source of facts and ideas, to which they added their distinctive overlay." *Id.* at 1543. Although *Nash* involved the alleged appropriation only of a plot line, its broad reasoning is equally applicable to incidental appropriation of expressive elements as well.

All of these cases establish that an author is permitted to engage in incidental appropriation of expressive elements from a historical, factual work. Because the Tenth Circuit's decision is contrary to the overwhelming weight of authority, and especially in view of this Court's demonstrated willingness to ensure uniformity on important questions of copyright law, *certiorari* is warranted.

C. The Question Presented Is A Recurring One Of Exceptional Importance.

The Tenth Circuit's outlying decision will have enormous practical implications. As the cases discussed above reflect, facts from copyrighted historical works are used in a variety of contexts—from novels to subsequent historical works, from movies to documentaries. It is inevitable that, in taking facts from copyrighted historical works, authors will copy incidental words or

phrases as well. *See, e.g.*, *Harper & Row*, 471 U.S. at 585-86 (Brennan, J., dissenting); *Narell*, 872 F.2d at 911.

Through provisions such as 17 U.S.C. § 102(b), which excludes facts and ideas from copyright protection, the Copyright Act balances the desire to reward authors for their creations with the desire to protect and encourage intellectual development, which is possible only if one author can build on the work of others. *See, e.g.*, *Nash*, 899 F.2d at 1540. By holding authors liable for copyright infringement if the factual details of their work too closely resemble the factual details of a previous work, even if the facts are retold almost entirely in the authors' own words, the Tenth Circuit unduly and radically shifts this statutory balance in the copyright holder's favor.

As then-Chief Judge Kaufman of the Second Circuit succinctly put it: "[t]o avoid a chilling effect on authors who contemplate tackling a historical issue or event, broad latitude must be granted to subsequent authors who make use of historical subject matter." *Hoehling*, 618 F.2d at 978. This Court should grant *certiorari* in order to provide guidance in this vitally important area, and to ensure that Congress' carefully crafted balance is protected.

CONCLUSION

For the foregoing reasons, this Court should grant the petition for writ of *certiorari*.

Respectfully submitted,

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September 23, 2002

APPENDIX

APPENDIX
TABLE OF CONTENTS

Page

Opinion of the Court of Appeals,
April 19, 2002 ..... 1a

Order of the Court of Appeals Denying Petition for Rehearing *En Banc*,
June 24, 2002 ..... 28a

Order of the District Court,
January 11, 2001 ..... 30a

APPENDIX A

IN THE UNITED STATES COURT OF APPEALS
FOR THE TENTH CIRCUIT

Nos. 01-4027 & 01-4036

GENE S. JACOBSEN,

Plaintiff-Appellant and Cross-Appellee,

versus

DESERET BOOK COMPANY, a Utah corporation;
DEAN HUGHES,

Defendants-Appellees and Cross-Appellants.

Appeal from the United States District Court
for the District of Utah

April 19, 2002

Before **KELLY**, Circuit Judge, **BRORBY**, Senior Circuit Judge, and **MURPHY**, Circuit Judge.

BRORBY, Senior Circuit Judge:

I. Introduction

Dr. Gene S. Jacobsen was a prisoner of war in the Philippines and Japan during World War II. After returning from military service, Dr. Jacobsen wrote his personal memoir entitled *Who Refused to Die.* In gripping detail, *Who Refused to Die* recounts Dr. Jacobsen's survival of the Bataan Death March and subsequent years of imprisonment and torture in various work camps.

In 1997, Deseret Book Company ("Deseret Book") published the first of a five-volume series written by Dr. Dean Hughes entitled *Children of the Promise.*[1] The series is a fictional work written primarily for members of the Church of Jesus Christ of Latter-day Saints. It portrays a Latter-day Saint family's life during World War II. The story of Wally Thomas, one of the family's sons, closely follows Dr. Jacobsen's experiences as related in *Who Refused to Die.*

In 1999, Dr. Jacobsen filed a complaint against Dr. Hughes and Deseret Book seeking an injunction and damages for copyright infringement under 17 U.S.C. §§ 106 and 501. After nearly a year of discovery, Deseret Book filed a motion asking the district court to dismiss the complaint for failure to state a claim pursuant to Federal Rule of Civil Procedure 12(b)(6) and award Deseret Book attorney fees. Dr. Hughes joined Deseret Book's Rule 12(b)(6) motion and filed a motion for summary judgment on several affirmative defenses. The district court granted the Rule 12(b)(6) motion, granted summary judgment on the affirmative defense of laches, and denied the request for attorney fees.

On appeal, Dr. Jacobsen challenges the district court's dismissal of his complaint pursuant to Fed.R.Civ.P. 12(b)(6) as well as the court's granting summary judgment on the affirmative defense of laches. Dr. Jacobsen also appeals the district court's refusal to strike defendants' expert reports or allow Dr. Jacobsen additional time to designate expert witnesses. Dr. Hughes and Deseret Book filed a cross-appeal seeking attorney fees. We exercise jurisdiction under 28 U.S.C. § 1291 and reverse the 12(b)(6) dismissal, the grant of summary judgment on laches, and the refusal to strike the expert reports. Both Dr. Jacobsen's request for additional time to

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[1] The individual volumes are titled, beginning with the first, *Rumors of War; Since You Went Away; Far From Home; When We Meet Again;* and *As Long as I Have You.*

designate experts and Dr. Hughes' and Deseret Book's request for attorney fees are moot.

II. Motion to Dismiss

Dr. Jacobsen argues the district court erred in granting Dr. Hughes' and Deseret Books' motion to dismiss.[2] "We review a dismissal under Rule 12(b)(6) de novo." *Wark v. United States*, 269 F.3d 1185, 1190 (10th Cir.2001). Our "'function on a Rule 12(b)(6) motion is not to weigh potential evidence that the parties might present at trial, but to assess whether the plaintiff's complaint alone is legally sufficient to state a claim for which relief may be granted.'" *Sutton v. Utah State Sch. for the Deaf & Blind*, 173 F.3d 1226, 1236 (10th Cir.1999) (quoting *Miller v. Glanz*, 948 F.2d 1562, 1565 (10th Cir.1991)).

In addition to the complaint, the district court may consider documents referred to in the complaint if the documents are central to the plaintiff's claim and the parties do not dispute the documents' authenticity. *See GFF Corp. v. Associated Wholesale Grocers, Inc.*, 130 F.3d 1381, 1384 (10th Cir.1997). Because Dr. Jacobsen's complaint referred to *Who Refused to Die* and the *Children of the Promise* series, and all the parties invited the

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[2] Normally a motion to dismiss for failure to state a claim upon which relief can be granted should be made prior to filing the answer or in the answer itself. Fed.R.Civ.P. 12(b)(6). If the defendant makes the motion after filing the answer, the motion should generally be treated as a motion for judgment on the pleadings. Fed.R.Civ.P. 12(c), (h)(2); *Lowe v. Town of Fairland, Okla.*, 143 F.3d 1378, 1381 n. 5 (10th Cir.1998); *Republic Steel Corp. v. Pennsylvania Eng'g Corp.*, 785 F.2d 174, 182 (7th Cir.1986). In keeping with the parties' designation, we refer to the motion as a 12(b)(6) motion to dismiss. We use the same standard when evaluating 12(b)(6) and 12(c) motions. *See Atlantic Richfield Co. v. Farm Credit Bank of Wichita*, 226 F.3d 1138, 1160 (10th Cir.2000) ("A motion for judgment on the pleading under Rule 12(c) is treated as a motion to dismiss under Rule 12(b)(6)."). Therefore, in this case, our decision would be the same whether considered as a 12(b)(6) motion or a 12(c) motion.

district court to consider these works, the district court properly considered the work in ruling on the 12(b)(6) motion.[3] *See Lewis v. Kroger Co.*, 109 F.Supp. 484, at 486 (S.D.W.Va.1952) (considering original and allegedly copied material in ruling on 12(b)(6) motion). When a district court considers the original work and the allegedly copyrighted work in deciding a 12(b)(6) motion, the legal effect of the works are determined by the works themselves rather than by allegations in the complaint. *See Droppleman v. Horsley*, 372 F.2d 249, 250 (10th Cir.1967) (holding the legal effect of an incorporated document considered on a motion to dismiss "'is to be determined by [the document's] terms rather than by the allegations of the pleader'" in the complaint) (quoting *Zeligson v. Hartman-Blair, Inc.*, 126 F.2d 595, 597 (10th Cir.1942)).

We cannot affirm the dismissal for failure to state a claim unless, after considering the complaint, *Who Refused to Die*, and the *Children of the Promise* series[4] in the light most favorable to Dr. Jacobsen, it appears beyond doubt Dr. Jacobsen can prove no set of facts in support of his claim that would entitle him to relief. *Stidham v. Peace Officer Standards & Training*, 265 F.3d 1144, 1149 (10th Cir.2001). To establish copyright infringement,

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[3] Although Dr. Jacobsen told the district court it could consider the *Children of the Promise* books, at oral argument on appeal Dr. Jacobsen argued we should consider only the complaint. We need not consider Dr. Jacobsen's new-found objection to reviewing the *Children of the Promise* series. *See John Zink Co. v. Zink*, 241 F.3d 1256, 1259 (10th Cir.2001) (quoting *United States v. Edward J.*, 224 F.3d 1216, 1222 (10th Cir.2000)) ("'The invited error doctrine prevents a party from inducing action by a court and later seeking reversal on the ground that the requested action was error.'").

[4] Despite the importance of the *Children of the Promise* series to this appeal, none of the parties designated the series as part of the record on appeal. We, therefore, have *sua sponte* supplemented the record with the five-volume *Children of the Promise* series. *See* 10th Cir. R. 10.3(B); *Cox v. United States*, 881 F.2d 893, 894 n. 1 (10th Cir.1989).

Dr. Jacobsen must prove "(1) ownership of a valid copyright and (2) 'copying of constituent elements of the work that are original.'" *TransWestern Publ'g Co., v. Multimedia Mktg. Assocs.*, 133 F.3d 773, 775 (10th Cir.1998) (quoting *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (1991)). The complaint clearly alleges Dr. Jacobsen has a federally registered copyright for *Who Refused to Die.* Thus, we need only determine whether the complaint and incorporated documents are sufficient to allege Dr. Hughes and Deseret Book copied *Who Refused to Die.*

Whether Dr. Hughes and Deseret Book copied *Who Refused to Die* "involves two distinct inquiries: first, whether [Dr. Hughes], as a factual matter, copied [Dr. Jacobsen's] work, and second, whether, as a mixed issue of fact and law, those elements that were copied were protected." *Country Kids 'N City Slicks, Inc. v. Sheen*, 77 F.3d 1280, 1284 (10th Cir.1996). After reviewing the complaint and incorporated documents, we are satisfied Dr. Jacobsen could present evidence showing Dr. Hughes copied many of the experiences Dr. Jacobsen recorded in *Who Refused to Die.* The difficulty in this case arises in determining whether Dr. Hughes copied only unprotected facts or instead impermissibly copied Dr. Jacobsen's original expression.

It is well settled "no author may copyright facts or ideas." *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 547 (1985). Thus, the copyright of a nonfiction work protects only "those aspects of the work—termed 'expression'—that display the stamp of the author's originality." *Id. See also Feist*, 499 U.S. at 348 ("[C]opyright protection may extend only to those components of a work that are original to the author."). "[A] copyright does not prevent subsequent users from copying from a prior author's work those constituent elements that are not original —for example * * * facts, or materials in the public domain—as long as such use does not unfairly appropriate the author's original contributions." *Harper & Row*, 471 U.S. at 548 (quotation marks and citations omitted).

In order to prove copying of legally protectible material, a plaintiff must typically show substantial similarity between legally protectible elements of the original work and the allegedly infringing work. *Country Kids 'N City Slicks,* 77 F.3d at 1284. "This is primarily a qualitative rather than a purely quantitative analysis, and must be performed on a case-by-case basis." *Gates Rubber Co. v. Bando Chem. Indus., Ltd.,* 9 F.3d 823, 839 (10th Cir.1993) (citation and footnote omitted).[5] To decide whether two works are substantially similar we ask "'whether the accused work is so similar to the plaintiff's work that an ordinary reasonable person would conclude that the defendant unlawfully appropriated the plaintiff's protectible expression by taking material of substance and value.'" *Country Kids 'N City Slicks,* 77 F.3d at 1288 (quoting *Atari, Inc. v. North Am. Philips Consumer Elecs. Corp.,* 672 F.2d 607, 614 (7th Cir.1982)). Determining whether there is

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[5] In determining whether a defendant has copied legally protectible material, we have sometimes found it useful to use an abstraction-filtration-comparison analysis. *See Country Kids 'N City Slicks,* 77 F.3d at 1284-85; *Gates Rubber,* 9 F.3d at 834. We have described this analysis as follows:

> At the abstraction step, we separate the ideas (and basic utilitarian functions), which are not protectable, from the particular expression of the work. Then, we filter out the nonprotectable components of the product from the original expression. Finally, we compare the remaining protected elements to the allegedly copied work to determine if the two works are substantially similar.

Country Kids 'N City Slicks, 77 F.3d at 1284-85. While abstraction-filtration-comparison analysis is useful in a variety of copyright cases, not every case requires extensive analysis. *Mitel, Inc. v. Iqtel, Inc.,* 124 F.3d 1366, 1372 (10th Cir.1997). Rather, "'the appropriate test to be applied and the order in which its various components are to be applied * * * may vary depending upon the claims involved, the procedural posture of the suit, and the nature of the [works] at issue.'" *Id.* (quoting *Gates Rubber,* 9 F.3d at 834 n. 12). Regardless of our method of distilling the protectible aspects of *Who Refused to Die,* the ultimate issue is whether the *Children of the Promise* series is substantially similar to protectible aspects of *Who Refused to Die. See Gates Rubber,* 9 F.3d at 839.

substantial similarity in cases involving fact-based works is particularly difficult.

> [T]he measure of how substantial a "substantial similarity" must be may vary according to circumstances. For many copyrights represent significant creative effort, and are therefore reasonably robust, whereas others reflect only scant creativity; the Supreme Court labels the latter "thin." It would seem to follow analytically that more similarity is required when less protectible matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, "supersubstantial" similarity must pertain when dealing with "thin" works.

4 Melville B. Nimmer & David Nimmer, *Nimmer on Copyright* § 13.03[A], at 13-28 (2000) (hereinafter *Nimmer*). *See also TransWestern,* 133 F.3d at 776 (relying on Nimmer's "supersubstantial" similarity analysis). Because "[n]o easy rule of thumb can be stated as to the quantum of fragmented literal similarity permitted without crossing the line of substantial similarity," whether works are substantially similar is "a classic jury question." 4 *Nimmer, supra,* § 13.03[A][2], at 13-46 and n. 96 (2001). *Cf. King of the Mountain Sports, Inc. v. Chrysler Corp.,* 185 F.3d 1084, 1089 (10th Cir.1999) (holding the trier of fact should normally make the determination of similarity in a trademark infringement case, but the court can monitor the "outer limits" of similarity if "reasonable minds" could not differ on the question). In applying these principles to Dr. Jacobsen's appeal, we first distinguish the supersubstantial similarity analysis relied on by the district court. Then, we compare *Who Refused to Die* and the *Children of the Promise* series addressing precedent relied upon by Dr. Hughes and Deseret Book.

In ruling on the motion to dismiss, the district court found "[Dr.] Hughes copied some 'facts' from [Dr.] Jacobsen's memoir, but not significant original expression." Relying on *Feist Publications, Inc.*

v. Rural Telephone Service Co., 499 U.S. 340 (1991), and *TransWestern Publishing Co. v. Multimedia Marketing Associates*, 133 F.3d 773 (10th Cir.1998), two cases involving copied telephone directories, the district court applied a supersubstantial similarity test rather than the substantial similarity requirement traditionally applied in copyright infringement cases. The court noted several differences between *Who Refused to Die* and the character Wally in the *Children of the Promise Series*.

> Much of the *Children of the Promise* series deals with spiritual matters and a [sic] most of the volumes are devoted to Wally's large and extended family. [Dr.] Jacobson's [sic] memoir, on the other hand, does not emphasize spiritual matters except in passing. * * * Further, the memoir deals only with [Dr.] Jacobsen's experiences in a limited matter and does not expand much over time and geography as do [Dr.] Hughes' novels. It is clear to this court that Wally is not Gene Jacobsen.

Consequently, the district court concluded under "the * * * supersubstantial similarity test it is clear that [Dr.] Hughes did not copy any protectable aspects of the memoir."

We disagree. First, we conclude the district court gave undue weight to language in *Feist* and *TransWestern* incorrectly applying a "supersubstantial similarity test" in evaluating whether Dr. Hughes and Deseret Book copied protected elements of *Who Refused to Die*. In *Feist*, the Supreme Court held "the copyright in a factual compilation is thin." *Feist*, 499 U.S. at 349. In *TransWestern*, we stated "if substantial similarity is the normal measure required to demonstrate infringement, 'supersubstantial' similarity must pertain when dealing with thin works." *TransWestern*, 133 F.3d at 776 (quoting 4 *Nimmer, supra*, § 13.03[A], at 13.28 (1997)). The district court seized this language and applied what it called "the Tenth Circuit supersubstantial similarity test." We do not read *TransWestern* so broadly as to require us to apply a

supersubstantial similarity test to all fact-based works. Rather *TransWestern* merely reaffirmed "the measure of how substantial a 'substantial similarity' must be may vary according to circumstances." 4 *Nimmer, supra*, § 13.03[A], at 13-28 (2000). Because fact-based works differ "as to the relative proportion of fact and fancy," *Harper & Row*, 471 U.S. at 563, the quantum of similarity required to establish infringement differs in each case. Merely applying a supersubstantial similarity test to all fact-based works would ignore the differences between "sparsely embellished maps and directories" and "elegantly written biography." *Id.* In short, *Who Refused to Die* involves more creative effort and original expression than the telephone directories at issue in *Feist* and *TransWestern*. Therefore, Dr. Jacobsen could prove substantial similarity with less similarity than we would require if the allegedly infringed work were a telephone directory.[6]

Second, although the district court's catalogue of differences between *Who Refused to Die* and the *Children of the Promise* series is accurate, it is largely irrelevant. We realize the five-volume *Children of the Promise* series contains much material not taken from the single-volume *Who Refused to Die*. However, "a taking may not be excused merely because it is insubstantial with respect

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[6] Dr. Hughes and Deseret Book do not agree *Who Refused to Die* is entitled to greater protection than a telephone directory. They point to a sentence in *Harper & Row*: "The extent to which one must permit expressive language to be copied, in order to assure dissemination of the underlying facts, will thus vary from case to case." *Harper & Row*, 471 U.S. at 563 (quotation marks and citation omitted). Dr. Hughes and Deseret Book argue "[t]he point of this quotation, then, is that even highly creative expression might receive *less* protection when it is used to describe facts than it would in a fictional work." (Emphasis in original.) We agree *Who Refused to Die* should receive less protection than a purely fictional novel. However, we cannot see how this proposition leads to the conclusion *Who Refused to Die* should be treated as a telephone directory. We believe the quotation from *Harper & Row* merely reinforces the view substantial similarity should be decided on a case-by-case basis.

to the *infringing* work. As Judge Learned Hand cogently remarked, 'no plagiarist can excuse the wrong by showing how much of his work he did not pirate.'" *Harper & Row*, 471 U.S. at 565 (quoting *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49, 56 (2d Cir. 1936)). "The question in each case is whether the similarity relates to matter that constitutes a substantial portion of plaintiff's work—not whether such material constitutes a substantial portion of defendant's work." 4 *Nimmer, supra*, § 13.03[A][2], at 13-46 (2001). Thus we are not concerned with whether the copied material is a substantial part of the *Children of the Promise* series. Rather, we must consider whether Dr. Hughes and Deseret Book copied a substantial portion of *Who Refused to Die*.

With these clarifications in mind, we next compare *Who Refused to Die* and the *Children of the Promise* series. It is clear Dr. Hughes copied much of the plot line for Wally Thomas from *Who Refused to Die*. As we need not weigh the evidence, we make no attempt to compile an exhaustive list of protectible material a jury could find to have been copied. Suffice it to say the similarity goes beyond the bare facts that both works describe a World War II Army Air Corps Supply Sergeant who was captured by the Japanese, forced to march across the Bataan Peninsula, and imprisoned in various work camps. Both works tell how Japanese planes bombed an air field just as a soldier was delivering cigars.[7]

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[7] Dr. Jacobsen's memoir states:

> Not far from where I stood he stopped the truck and got out. He took from the seat of the truck a box of cigars that he had scrounged from somewhere. He opened the box and placed it on the truck's hood. Then, he dipped both hands into the box and came out with a double handful of cigars. Coming towards the trees, he began shouting, "Cigars? Cigars! Does anyone want a cigar?"
>
> Laughing at his antics, I turned around to see if he had any takers. No one was in sight.

Both describe a Japanese officer's anguish after he discovered an American prisoner of war serving on a work detail accidentally pulled up baby carrot plants.[8] Both recount the "humiliation" the

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> Instinctively I turned towards the small tower which had been constructed. Sure enough, the red flag was whipping excitedly in the breeze as if its very movement would be sufficient to alert us of approaching enemy planes.
>
> Almost simultaneously I heard the shrill, chilling whistle of the bombs from the Japanese planes overhead as they made their treacherous descent towards Clark Field.

Gene S. Jacobsen, *Who Refused to Die* 20 (Jan. 1, 1995) (unpublished manuscript). Dr. Hughes wrote:

> He braked and then bounced out of the truck. He had a box in his hand, which he slapped onto the hood of the truck. Then he reached in and pulled out a double handful of cigars. "Cigars! Cigars!" he yelled above the drone of the engines.
>
> Wally wondered where Sandy had managed to scrounge a box of cigars, and he looked around to see who wanted one—but saw no one at all. Instantly, Wally guessed what was happening. He spun to look at the lookout tower the men had built. A red flag was waving in the breeze—the sign for an air attack. At the same moment, Wally heard the whistle of dropping bombs.

Dean Hughes, 1 *Children of the Promise: Rumors of War* 436 (1997).

[8] *Who Refused to Die* reads:

> The Jap, seeing what had happened, dropped to his knees and picked up a handful of the weeds and carrots. Though he couldn't speak a word of English, it was easy, from the expression on his face and from his voice, to tell what he was thinking and saying as he separated the carrots from the weeds. I know he must have been quietly sobbing, "My poor little carrots, my poor little carrots."

Jacobsen, *supra,* at 133. *Children of the Promise* reads:

> I thought for a minute the Jap was going to cry. He bent down and showed Frank which ones were carrots and which were weeds. He hardly knew a word of English, but he kept showing ol' Frank and jabbering away. It was almost like he was saying, "Oh, son, look what you've done to my lovely little carrots."

protagonist felt when guards assigned him to the "honey detail" and required him to empty their outhouses.[9] In some instances, the copying goes beyond close paraphrasing and reproduces Dr. Jacobsen's words exactly. Consider the following example. The first paragraph is Dr. Jacobsen's description of his journey to unite with American troops after the war ended. The second is Dr. Hughes' description of the same event in the fictional life of Wally Thomas.

> Approaching the sailors the second time, one of the fellows drove his souvenir sword into the deck of the ship and said somewhat fiercely, "*Listen you guys! General MacArthur* said that we had the authority *to use any means* of transportation *necessary* to get out of Japan, and this boat is necessary for us to reach American troops. *We* are *going to* get across *this bay with you or without you. If you want to take us across and get paid for your troubles, fine. If you don't, get off the ship, and we'll take* ourselves across!"

Jacobsen, *supra,* at 193-94 (emphasis added).

Dean Hughes, 2 *Children of the Promise: Since You Went Away* 188 (1997).

[9] *Who Refused to Die* at 130.

> The assignment to be avoided if at all possible, was the "honey" detail that daily cleaned the Japanese toilets and carried the contents to the farm where it was spread around the plants. The work was bearable, but the humiliation was almost too great.

Children of the Promise, Vol. 2 at 186.

> Each morning Wally would receive a work assignment. * * * [W]orst of all was the "honey" detail. The work was not terribly strenuous, but the humiliation was almost more than he could stand. A work crew would carry the contents of the outhouses to the fields, an then they would spread the human waste around the plants in the garden.

> This time it was Potts who walked on ahead. He was carrying a souvenir sword of his own. When he stepped onto the deck, he shouted, "We need to talk," and he slammed his sword into the deck, sticking it up by its point. * * * "*Listen* to me *you guys,*" Potts went on. "*General* Douglas *MacArthur* has authorized us *to use any means* we find *necessary* to reach American troops. *We*'re *going to* cross *this bay with you or without you. If you want to take us across and get paid for your troubles, fine. If you don't, get off the ship, and we'll take* her across ourselves."

Dean Hughes, 4 *Children of the Promise: When We Meet Again* 427-28 (1999) (emphasis added).

Dr. Hughes and Deseret Book do not believe these and other passages reveal copying. They argue "[Dr.] Hughes never copied [*Who Refused to Die*] verbatim. He retold the factual events in his own words and style, and he placed them in a fictional context of his own creation." We disagree. Dr. Hughes and Deseret Book never directly address why the preceding example and others do not amount to verbatim copying. Instead, they cite several cases suggesting some verbatim copying is permissible. *See Narell v. Freeman,* 872 F.2d 907, 911 (9th Cir.1989); *Suid v. Newsweek Magazine,* 503 F.Supp. 146, 148 (D.D.C.1980); *Alexander v. Haley,* 460 F.Supp. 40, 46 (S.D.N.Y.1978); *Norman v. Columbia Broad. Sys., Inc.,* 333 F.Supp. 788, 797 (S.D.N.Y.1971). We conclude these cases are inapplicable to the case before us.

Narell, Alexander, and *Norman* are distinguishable because those cases involved verbatim copying of only a few words and phrases. *See Narell,* 872 F.2d at 911; *Alexander,* 460 F.Supp. at 46; *Norman,* 333 F.Supp. at 797. For example, in *Narell* the court held there was no copyright infringement when the verbatim copying amounted to a few descriptive phrases like "cow path" and

"hordes of gold seekers." *Narell*, 872 F.2d at 911. Indeed, the above cited example from the *Children of the Promise* series reveals Dr. Hughes and Deseret Book arguably copied more than a few words and phrases.

Suid is also inapplicable. In *Suid*, the court held "[t]he author of a factual work may not * * * claim copyright in statements made by others and reported in the work since the author may not claim originality as to those statements." *Suid*, 503 F.Supp. at 148. We acknowledge the words contained in both paragraphs of the above-cited example were enclosed in quotation marks. We agree quotations may be freely copied if the quotation is recorded contemporaneously or taken directly from a written source as in *Suid*. Dr. Jacobsen did not, however, contemporaneously record the quotations or copy them from a written source. For this reason, a trier of fact might conclude the material in quotation marks in *Who Refused to Die* was original expression rather than the actual words used. Dr. Jacobsen may have enclosed the material in quotations merely to allow him to speak in the voice of a third party while recording his story. Because the issue of whether the dialogue in Who Refused to Die is original expression or fact turns, at least in part, on additional evidence to be presented at trial, the question should be determined by the trier of fact rather than the court.

The Supreme Court's decision in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985), is particularly instructive on the issue of verbatim copying. In *Harper & Row*, the Supreme Court upheld a district court's finding of copyright infringement. *Id.* at 541-42. Harper & Row owned the copyright to President Ford's unpublished memoir. *Id.* at 542. Prior to publication of the memoir, a magazine obtained a copy of the memoir and published an article including verbatim quotes from the memoir. *Id.* at 542-43. The Supreme Court held even though President Ford's memoir was a factual work, the magazine's verbatim copying of the memoir appropriated original expression and amounted to copyright infringement. *Id.* at 548-49. Likewise,

when viewed in the light most favorable to Dr. Jacobsen, the *Children of the Promise* series contains passages arguably copied verbatim from *Who Refused to Die*. Because *Harper & Row* establishes verbatim copying from a memoir appropriates the author's original expression, we could only uphold the district court's dismissal if the copying were so minor as to be beyond the outer limits of substantial similarity. We conclude the copying is not so minor as to remove the substantial similarity decision from the domain of the trier of fact.

Because we hold the *Children of the Promise* series contains enough material for a trier of fact to find verbatim copying, we need not address whether close paraphrasing of an historical work is sufficient to establish a copyright violation.[10] *See id.* at 548. We acknowledge the Supreme Court has not settled this issue. However, the Second Circuit has held close paraphrasing of unpublished letter in an historical biography violated copyright law. *Salinger v. Random House, Inc.*, 811 F.2d 90, 93, 96-97 (2d Cir.1987). Nothing in our opinion would preclude the Tenth Circuit from adopting the Second Circuit's approach in the future.

In conclusion, when viewing the complaint, the *Children of the Promise* series, and *Who Refused to Die* in the light most favorable to Dr. Jacobsen, we conclude Dr. Jacobsen could prove a set of facts entitling him to relief. Portions of the *Children of the Promise* series could be seen as verbatim copying of Dr. Jacobsen's original expression. These instances are numerous enough to allow a jury to determine whether the works are

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[10] For this reason we do not undertake extensive analysis of two cases cited by Dr. Hughes and Deseret Book. In their brief, Dr. Hughes and Deseret Book direct us to *Walker v. Time Life Films, Inc.*, 615 F.Supp. 430 (S.D.N.Y.1985) and *Polsby v. St. Martin's Press, Inc.*, No. 97 Civ. 690(MBM), 1999 WL 225536 (S.D.N.Y. Apr.19, 1999) (unpublished decision). Neither of these cases involved verbatim copying. *Walker*, 615 F.Supp. at 436-37; *Polsby*, 1999 WL 225536, at *4. Similarly, we need not analyze portions of *Narell* discussing paraphrasing to reach our decision in this case.

substantially similar. We, therefore, reverse the district court's ruling on the 12(b)(6) motion.

III. Laches

Next, we address whether the district court correctly granted summary judgment after determining Dr. Jacobsen's claims were barred by laches. Because there are disputes as to material facts, we hold the district court erred in granting summary judgment on the laches issue.

As an initial matter, we must determine the appropriate standard for reviewing the district court's decision. Dr. Jacobsen argues we should apply a *de novo* standard. In contrast, Dr. Hughes advocates an abuse of discretion standard. We have used the abuse of discretion standard to review a district court's application of the laches defense after a bench trial. *Mile High Indus. v. Cohen,* 222 F.3d 845, 852, 857 (10th Cir.2000); *Jicarilla Apache Tribe v. Andrus,* 687 F.2d 1324, 1328, 1337 (10th Cir.1982). However, when a district court applies the laches doctrine to dismiss a claim on summary judgment, we review the district court's decision de novo. *Hutchinson v. Pfeil,* 105 F.3d 562, 564 (10th Cir.), *cert. denied,* 522 U.S. 914 (1997). In keeping with Tenth Circuit precedent, we apply de novo review in this case.[11]

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[11] Some circuits use a bifurcated standard to review a district court's grant of summary judgment on a laches defense. For example, the Seventh Circuit held "while our review of the record is *de novo* in determining whether there are any disputed issues of material fact, our review of whether the district court properly applied the doctrine of laches is under an abuse of discretion standard." *Hot Wax, Inc. v. Turtle Wax, Inc.*, 191 F.3d 813, 819 (7th Cir.1999). *See also Wanlass v. General Elec. Co.*, 148 F.3d 1334, 1337 (Fed.Cir.1998); *National Ass'n of Gov't Employees v. City Pub. Serv. Bd.*, 40 F.3d 698, 707-08 (5th Cir.1994). Although we do not adopt this approach, we note our decision would be the same under this standard. Our de novo review of the record convinces us there are genuine issues of material fact. Consequently, we would not need to undertake the abuse of discretion

"Summary judgment is appropriate if there is no genuine issue as to any material fact and the moving party is entitled to judgment as a matter of law." *Hutchinson,* 105 F.3d at 564. "In determining whether the defendant is entitled to summary judgment, we view all facts and reasonable inferences therefrom in the light most favorable to the plaintiff." *Id.* (citing *Anderson v. Liberty Lobby, Inc.,* 477 U.S. 242, 255 (1986)).

"In order to prove the affirmative defense of laches, the defendant must demonstrate that there has been an unreasonable delay in asserting the claim and that the defendant was materially prejudiced by that delay." *Hutchinson,* 105 F.3d at 564. "Generally speaking, the relevant delay is the period from when the plaintiff knew (or should have known) of the allegedly infringing conduct, until the initiation of the lawsuit in which the defendant seeks to counterpoise the laches defense." *Danjaq LLC v. Sony Corp.,* 263 F.3d 942, 952 (9th Cir.2001).

In granting Dr. Hughes' summary judgment motion, the district court noted "the facts in this matter are highly disputed; however the facts regarding laches * * * are to be determined by the court." The district court then found "[Dr.] Jacobsen had knowledge of the material used by [Dr.] Hughes as early as 1994 and no later than 1996." In addition, the court found Dr. Jacobsen "had ample opportunity to let [Dr.] Hughes know of his disapproval as early 1996" but instead delayed in bringing his claim until 1999 causing "extreme prejudice to [Dr.] Hughes." Consequently, the district court concluded Dr. Jacobsen's claims were barred by laches.

We disagree with the district court's conclusion summary judgment was appropriate on the issue of laches. Although a district court can make factual findings related to laches after a bench trial, *Mile High Indus.,* 222 F.3d at 857, the court should not make factual findings when addressing a summary judgment

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analysis.

motion based on laches, *Hutchinson,* 105 F.3d at 564. Rather than deferring to district court's finding of fact, we view the record in the light most favorable to Dr. Jacobsen. *Id.* When viewing the record in this light, we find disputes of material facts. If Dr. Jacobsen's version of the facts are accepted, Dr. Hughes is not entitled to summary judgment on the laches defense.

Both parties agree Dr. Jacobsen and Dr. Hughes first met in 1994. As the district court found, "what happened at the meeting and thereafter is heavily disputed by the parties." In his deposition, Dr. Jacobsen testified Dr. Hughes was interested in gathering background information on the war in the Pacific for use in writing a series of fictional books. Because he thought it would be useful as background information, Dr. Jacobsen gave Dr. Hughes a copy of *Who Refused to Die.* If this is accepted as true, we cannot see how this meeting could have alerted Dr. Jacobsen to the possibility Dr. Hughes would use *Who Refused to Die* in such a way as to raise copyright concerns.

Dr. Jacobsen's next contact with Dr. Hughes occurred in March 1996. The parties agree Dr. Hughes mailed Dr. Jacobsen a copy of a portion of the manuscript for the first book in *The Children of the Promise* series. The exact content of the material Dr. Hughes sent is disputed. Dr. Hughes contends the material should have put Dr. Jacobsen on notice of the nature of his use of *Who Refused to Die.* Dr. Jacobsen argues he did not receive all of the material Dr. Hughes claims to have sent. Dr. Jacobsen testified the materials did not include excerpts containing stories from *Who Refused to Die.* Although Dr. Jacobsen admitted he only "skimmed" the material, he testified he read the material carefully enough to identify any familiar stories. Again, if Dr. Jacobsen's version of the facts are accepted, we cannot conclude Dr. Jacobsen knew or should have known about potential copyright claims in 1996.

Dr. Hughes argues "even if we fully credit [Dr.] Jacobsen's testimony that he did not know exactly *how* [*Who Refused to Die*] was being used, he indisputably *should* have known, if that issue was of any concern to him at all." (Emphasis in original.) He suggests Dr. Jacobsen should have asked questions to ensure Dr. Hughes would not violate Dr. Jacobsen's copyright. While Dr. Jacobsen was expected to "exercise reasonable diligence in protecting his rights," *Jicarilla Apache Tribe,* 687 F.2d at 1338, laches should not be applied if Dr. Jacobsen was "justifiably ignorant of the facts creating his * * * cause of action," *Lawson v. Haynes,* 170 F.2d 741, 744 (10th Cir. 1948). We cannot conclude Dr. Jacobsen had a responsibility to inquire into Dr. Hughes' use of *Who Refused to Die* absent any reason to suspect Dr. Hughes was using *Who Refused to Die* in an inappropriate way. *See West v. American Tel. & Tel. Co.,* 311 U.S. 223, 240-41 (1940) (upholding a district court's rejection of laches defense even though the plaintiff did not conduct an inquiry to reveal unlawful conduct because there was no evidence suggesting the plaintiff had reason for suspicion).[12]

Next, Dr. Hughes argues Dr. Jacobsen should have discovered the nature of Dr. Hughes' use of *Who Refused to Die* when the first volume of the *Children of the Promise* series was published in March 1997. Because the district court relied on its factual determination that Dr. Jacobsen should have known about Dr.

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[12] Dr. Hughes argues Dr. Jacobsen should have been alerted to his use of *Who Refused to Die* because "the cover letter accompanying the excerpts [sent to Dr. Jacobsen in 1996] gave strong cues as to exactly how [Dr.] Hughes was using [*Who Refused to Die*]." We cannot conclude the letter, when viewed in the light most favorable to Dr. Jacobsen, raised the suspicion Dr. Hughes was inappropriately copying *Who Refused to Die*. The letter itself advised Dr. Jacobson, "[r]emember that Wally is not you." The letter also stated, "I am writing fiction and not telling *your* story." Thus, the letter could reasonably be viewed as confirming Dr. Jacobsen's belief Dr. Hughes was using *Who Refused to Die* only for background information.

Hughes' use of *Who Refused to Die* by 1996, the court did not consider whether laches would apply if the publication of the first volume was Dr. Jacobsen's first opportunity to discover his claims. We consider this argument because we can affirm for any reason supported by the record but not relied on by the district court. *Hayes v. Whitman,* 264 F.3d 1017, 1025 (10th Cir.2001).

Nevertheless, we conclude Dr. Hughes' argument is without merit.

Even if we assume the publication of the first volume of the *Children of the Promise* series should have immediately alerted Dr. Jacobsen to his potential copyright claims, we cannot conclude Dr. Jacobsen's claims are barred by laches. Dr. Jacobsen filed suit against Dr. Hughes and Deseret Book within three years of the publication of the first volume of the *Children of the Promise* series. Rather than deciding copyright cases on the issue of laches, courts should generally defer to the three-year statute of limitations, 17 U.S.C. § 507(b), provided by the Copyright Act.

> Because laches is a judicially created equitable doctrine, whereas statutes of limitations are legislative enactments, it has been observed that in deference to the doctrine of the separation of powers, the Supreme Court has been circumspect in adopting principles of equity in the context of enforcing federal statutes. Accordingly, when a limitation on the period for bringing suit has been set by statute, laches will generally not be invoked to shorten the statutory period.

United States v. Rodriguez-Aguirre, 264 F.3d 1195, 1207-08 (10th Cir.2001) (quotation marks, citations, and alterations omitted). *See also Lyons P'ship, L.P. v. Morris Costumes, Inc.,* 243 F.3d 789, 797 (4th Cir.2001) (holding "separation of powers principles dictate that an equitable timeliness rule adopted by courts cannot bar claims that are brought within the legislatively prescribed statute of limitations" in the Copyright Act). Although "it is possi-

ble, in rare cases, that a statute of limitations can be cut short by the doctrine of laches," *Rodriguez-Aguirre,* 264 F.3d at 1208, we see no reason to supplant the statute of limitations in this case.

In arguing laches should be applied in this case, Dr. Hughes directs us to *Jackson v. Axton,* 25 F.3d 884, 888 (9th Cir.1994), *overruled on other grounds by Fogerty v. Fantasy, Inc.,* 510 U.S. 517, 531-32, 534 (1994). Although *Jackson* held a court can apply laches in a copyright case, the facts in *Jackson* are different from the facts before us. In *Jackson,* the plaintiff knew of his claim by 1975 but did not file suit until 1991. 25 F.3d at 886, 889. Given the prolonged delay, the Ninth Circuit held laches was applicable. *Id.* at 889. *See also Danjaq,* 263 F.3d at 950, 954 (upholding a district court's application of laches to prevent a plaintiff from pursuing copyright infringement claims when plaintiff filed suit "at least twenty-one years—and more likely, thirty-six years" after having knowledge of the potential claims). In contrast, Dr. Jacobsen filed suit less than three years after publication of the first volume. It does not seem unreasonable to allow Dr. Jacobsen three years from the time he should have known of his claim to evaluate the viability of instituting a lawsuit or pursue out-of-court remedies. *Cf. New Era Publ'ns Int'l v. Henry Holt & Co.,* 873 F.2d 576 (2d Cir.1989) (holding laches did not bar copyright holders' claims for damages when plaintiff learned of alleged infringement two years prior to bringing suit). Consequently, we defer to the Copyright Act's statute of limitations in this case.

When viewing the record in the light most favorable to Dr. Jacobsen, we conclude his delay in filing suit was reasonable. Consequently we need not address whether Dr. Hughes was materially prejudiced by the delay. We reverse the district court's ruling on the summary judgment motion and remand for further proceedings.

IV. Discovery Issues

Next, Dr. Jacobsen argues "[t]he district court erred in denying Dr. Jacobsen's motion for additional time to file rebuttal expert reports or in the alternative to strike defendant's expert reports and designations." We conclude the district court abused its discretion in refusing to strike the expert reports.

On August 1, 2000, Dr. Hughes and Deseret Book filed the reports of four expert witnesses, Marilyn A. Lashner, Merrill R. Norman, Paul Rawlins, and Allan Wittman, pursuant to Federal Rule of Civil Procedure 26(a)(2). Dr. Hughes and Deseret Book offered the expert reports to establish the bulk of the profits from the *Children of the Promise* series are attributable to their work rather than Dr. Jacobsen's work.

Rule 26(a)(2) requires expert reports "contain a complete statement of all opinions to be expressed." Fed.R.Civ.P. 26(a)(2)(B). A party is under a continuing duty to supplement the expert report if there are additions or changes to what has been previously disclosed. Fed.R.Civ.P. 26(a)(2)(C), 26(e)(1). "A party that without substantial justification fails to disclose information required by Rule 26(a) * * * is not, unless such failure is harmless, permitted to use as evidence at a trial * * * any * * * information not so disclosed." Fed.R.Civ.P. 37(c)(1). Arguing the expert reports were not complete, Dr. Jacobsen filed a motion asking the district court to postpone his deadline for filing rebuttal reports until after the defendant's expert reports were complete, or, in the alternative, strike the defendant's expert reports.

After a hearing on this issue, the district court denied Dr. Jacobsen's motion. It first noted Dr. Jacobsen was given the opportunity to submit his own expert reports to substantiate his claim of copyright infringement. Dr. Jacobsen did not submit expert reports because he believes he can establish copying through Dr. Hughes own admissions. The district court then reasoned Dr. Jacobsen "was fully aware that the burden regarding damages is the

defendants' burden," and "should not [have been] surprised that defendants did choose to rely on expert testimony in order to prove that profits were derived from material other than the allegedly copyrighted material." Consequently, the court concluded "[Dr. Jacobsen] had the same opportunity to provide expert witnesses as [Dr. Hughes and Deseret Book] and should not now be given an opportunity to file late reports or strike defendants' timely reports." Although the district court stated it had "considered the law * * * relevant to [Dr. Jacobsen's] motion," it did not mention Rule 26(a) or Rule 37(c).

In responding to Dr. Jacobsen's appeal, Dr. Hughes and Deseret Book do not argue their expert reports were complete. Instead, they claim the expert reports could not be complete because Dr. Jacobsen never "identified the alleged infringement with specificity." Because Dr. Jacobsen never provided a paragraph-by-paragraph analysis to show which portions of the *Children of the Promise* series were copied, Dr. Hughes and Deseret Book contend the expert reports were necessarily incomplete. Their experts "could only tell what method they would use" to calculate the profits attributable to Dr. Hughes and Deseret Book when they later "issue their final opinions." In addition, Dr. Hughes and Deseret Book argue the district court was within its discretion in refusing to grant Dr. Jacobsen additional time to file rebuttal expert reports. They believe allowing Dr. Jacobsen more time to file rebuttal expert reports would have "meant abandoning the trial date," which was set for January 8, 2001. Finally, Dr. Hughes and Deseret Book assert the incomplete reports did not preclude Dr. Jacobsen from filing rebuttal reports because Dr. Jacobsen could have submitted rebuttal expert reports with "the same level of generality" as the incomplete reports.

Because the district court did not find the expert reports complied with Rule 26(a), and Dr. Hughes and Deseret Book acknowledge the reports were preliminary and incomplete, we turn directly to the issue of whether Rule 37(c) nevertheless allows the

district court to allow the experts to testify on the basis of the incomplete reports. *See In re TMI Litigation Cases,* 922 F.Supp. 997, 1005 n. 9 (M.D.Pa.1996) (holding preliminary expert reports do not satisfy Rule 26(a)); *Smith v. State Farm Fire & Cas. Co.,* 164 F.R.D. 49, 53 (S.D.W.Va.1995) (same). Rule 37(c) permits a district court to refuse to strike expert reports and allow expert testimony even when the expert report violates Rule 26(a) if the violation is justified or harmless. Fed.R.Civ.P. 37(c). "The determination of whether a Rule 26(a) violation is justified or harmless is entrusted to the broad discretion of the district court." *Woodworker's Supply, Inc. v. Principal Mut. Life Ins. Co.,* 170 F.3d 985, 993 (10th Cir.1999). Nevertheless, we can hold the district court abused its discretion if the decision is based "on an erroneous conclusion of law," *Kiowa Indian Tribe v. Hoover,* 150 F.3d 1163, 1165 (10th Cir.1998), or would result in "fundamental unfairness in the trial of the case," *Orjias v. Stevenson,* 31 F.3d 995, 1005 (10th Cir.), *cert. denied,* 513 U.S. 1000 (1994).

Although a district court can allow evidence violating Rule 26(a) only if the violation was justified or harmless, *Jones v. Lincoln Elec. Co.,* 188 F.3d 709, 728 (7th Cir.1999), "[a] district court need not make explicit findings concerning the existence of a substantial justification or the harmlessness" of a Rule 26(a) violation, *Woodworker's Supply,* 170 F.3d at 993. Nevertheless, the court should consider the following factors: "(1) the prejudice or surprise to the party against whom the testimony is offered; (2) the ability of the party to cure the prejudice; (3) the extent to which introducing such testimony would disrupt the trial; and (4) the moving party's bad faith or willfulness." *Id.* We conclude the district court abused its discretion by misapplying two of these factors and not addressing the other two factors.

Initially, we note the district court did not address whether the Rule 26(a) violation was justified or harmless. With respect to the first factor, the district court opined Dr. Jacobsen should not have been surprised because experts are often used by defendants in

copyright cases. This ignores the purpose of Rule 26(a) expert reports. The reports are intended not only to identify the expert witness, but also "to set forth the substance of the direct examination." Fed.R.Civ.P. 26(a)(2) advisory committee note (1993). Such disclosure is necessary to allow the opposing party "a reasonable opportunity to prepare for effective cross examination and perhaps arrange for expert testimony from other witnesses." *Id.* Thus, to avoid prejudice Dr. Jacobsen needed to know the substance of the experts' testimony. After reviewing the expert reports, it appears likely the experts' testimony at trial will contain substantially more information than was presented in the expert reports. Dr. Lashner's report reveals she had reviewed *Who Refused to Die,* the first volume of the *Children of the Promise* series, and the jacket covers for volumes, two, three, and four of the series. At the time of her expert report she was "in the process of reviewing the remaining materials." Mr. Norman's report "summarize[d] the revenues, expenses and net profits associated with the *Children of the Promise* series through June 30, 2000." Mr. Rawlins' report warns his "percentages are for explanatory purposes only," and his report "is subject to amendment after additional analysis." Similarly, Mr. Whitman's report states he "expect[s] to do additional research on these issues between now and the trial and will refine these calculation." At trial, it is likely Dr. Hughes and Deseret Book will want Dr. Lashner to testify about her review of the complete series, Mr. Norman to testify about more recent revenue and expenses, and Mr. Rawlins and Mr. Whitman to testify about their refined calculations. We, therefore, cannot agree Dr. Jacobsen would not be prejudiced by the introduction of testimony not contained in the expert reports.

The second factor we consider is whether Dr. Jacobsen could somehow cure the potential prejudice. The district court suggests Dr. Jacobsen could have prevented potential prejudice if he had filed expert reports to support his copyright infringement claim. This finding suffers the same infirmity as the district court's analysis

on prejudice. Prejudice results because the expert reports did not reveal what the experts will testify to at trial. Therefore, nothing Dr. Jacobsen could have done prior to filing of the expert reports would have cured the prejudice. Dr. Hughes and Deseret Book argue Dr. Jacobsen could have filed rebuttal expert reports that were similarly general in nature. Again, this remedy would not eliminate prejudice because Dr. Jacobsen still would not know what testimony the defendants' experts would give at trial.

The district court's order does not reveal its analysis concerning the third factor. Even if the district court had made specific findings as to whether the undisclosed expert testimony would have disrupted the trial, the situation now facing the parties is somewhat different. As Dr. Hughes and Deseret Book argue, when the district court issued the order the scheduled trial date was just over a month away. Consequently, the court may have decided it would be less disruptive to allow testimony based on the incomplete reports than to allow Dr. Hughes and Deseret Book time to file complete reports. Since we are remanding this case for further proceedings, trial is no longer imminent and the district court could allow more time for discovery without disrupting a scheduled trial. *See Standard v. Union Pacific R.R. Co.*, 198 F.3d 258, 1999 WL 992973, at *3 (10th Cir. Nov. 2, 1999) (unpublished opinion) (reversing a district court's discovery ruling because, after a remand, trial was not imminent).

With respect to the fourth factor, the district court did not make a finding as to whether Dr. Hughes and Deseret Book acted in bad faith. Desert Book and Dr. Hughes argue they acted in good faith. They contend their expert reports would have been more complete if Dr. Jacobsen had been more forthcoming in responding to discovery requests. Generally, a court should "'not excuse non-compliance with Rule 26 by one party for the reason that the other party may not have fully complied'" with discovery requests. *Carney v. KMart Corp.*, 176 F.R.D. 227, 230 (S.D.W.Va.1997) (quoting *Smith*, 164 F.R.D. at 54). *See also Rambus, Inc. v.*

Infineon Techs. AG, 145 F.Supp.2d 721, 734 (E.D.Va.2001). If Dr. Hughes and Deseret Book thought Dr. Jacobsen had unfairly avoided discovery their recourse was a motion to compel. Fed.R.Civ.P. 37.

Assuming, however, Dr. Hughes and Deseret Book acted in good faith, their good faith alone would not be enough to overcome the other factors. If the experts are allowed to testify on the basis of their incomplete reports, Dr. Jacobsen will be prejudiced. Absent more complete disclosure by the experts, Dr. Jacobsen's prejudice cannot be cured. As the case is no longer on the eve of trial, the district court could allow Dr. Hughes and Deseret Book time to file complete expert reports without jeopardizing the trial schedule. If Dr. Hughes and Deseret Book are allowed to file complete reports, Dr. Jacobsen would have thirty days from the time the reports were filed to file rebuttal reports. Fed.R.Civ.P. 26(a)(2)(C). For these reasons, we reverse the district court's denial of Dr. Jacobsen's motion to strike the expert reports. In accordance with this decision, we need not address Dr. Jacobsen's alternative request for additional time to file rebuttal expert reports.

V. Attorney's Fees

Dr. Hughes and Deseret Book argue the district court should have awarded them attorney's fees because they were the prevailing party in an action under the Copyright Act. In light of our holding, this argument is moot.

VI. Conclusion

For the foregoing reasons we **REVERSE** the district court dismissal for failure to state a claim. We **REVERSE** the district court's grant of summary judgment on the laches defense. We also **REVERSE** the district court's refusal to strike four incomplete expert reports. The appeal relating to attorney's fees is moot, and we **REMAND** for further proceedings consistent with this opinion.

APPENDIX B

IN THE UNITED STATES COURT OF APPEALS FOR THE TENTH CIRCUIT

Nos. 01-4027 & No. 01-4036

GENE S. JACOBSEN,

Plaintiff-Appellant and Cross-Appellee,

versus

DESERET BOOK COMPANY, a Utah corporation; **DEAN HUGHES,**

Defendants-Appellees and Cross-Appellants.

Appeal from the United States District Court for the District of Utah

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ORDER
Filed June 24, 2002

Before **KELLY**, Circuit Judge, **BRORBY**, Senior Circuit Judge, and **MURPHY**, Circuit Judge.

Deseret Book Company and Dean Hughes' petition for rehearing is denied.

The suggestion for rehearing en banc was transmitted to all of the judges of the court who are in regular active service as required by Fed. R. App. P. 35. As no member of the panel and no judge in regular active service on the court requested that the court be polled, the suggestion is also denied.

Entered for the Court

PATRICK FISHER, Clerk of Court

by: /s/
Deputy Clerk

APPENDIX C

IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF UTAH
CENTRAL DIVISION

GENE S. JACOBSEN,
Plaintiff,

versus

DESERET BOOK COMPANY, a Utah corporation;
DEAN HUGHES,

Defendants.

Case No. 2:99-CV-893K

ORDER

This matter is before the court on defendant Deseret Book's Motion to Dismiss which has been joined in by defendant Dean Hughes; and defendant Hughes' separate Motion for Summary Judgment. Also before the court is defendants' Motion for Attorney's Fees and defendant Hughes' Motion to Strike factual assertions in Jacobsen's Memorandum in Opposition to the Motion for Summary Judgment. The matter came on for hearing on Monday December 4, 2000. The plaintiff was represented by Brent O. Hatch. Defendant Deseret Book was represented by Mary Ann Q. Wood. Defendant Hughes was represented by Kent B. Linebaugh. Oral argument was heard and the matter was taken under advisement. The court has considered all pleadings, memoranda, and other materials submitted by the parties. The

court has further considered the law and facts relevant to the parties' motions. Now being fully advised, the court enters the following order.

I. Factual Background

The plaintiff in this matter, Gene S. Jacobsen, alleges that defendant Hughes unlawfully copied Jacobsen's memoir, *Who Refused to Die,* in the writing of Hughes' successful five volume *Children of the Promise* series which is published by defendant Deseret Book. Jacobsen wrote his memoir *Who Refused to Die* shortly following his release as a war prisoner in 1945. The memoir is a personal account of Jacobsen's experiences in the Bataan Death March and as a prisoner of war in the Phillippines and in Japan. In 1978 Jacobsen made five typewritten copies for his family members. In 1981 Jacobsen revised the memoir and distributed about 100 copies, free of charge, throughout Singapore. In 1994 he again revised the manuscript making an additional 75 copies for family and friends. In the 1978 and 1981 versions Jacobsen included a copyright symbol on the manuscript. He did not include one initially on the 1994 version but added one later. The copyright was not registered until after this suit was commenced in 1999.

Defendant Dean Hughes entered into an agreement with Deseret Book in early 1994 to author his *Children of the Promise* series. At about this time he became acquainted with Jacobsen's memoir through his wife who worked with Jacobsen's son. Hughes requested a meeting with Jacobsen in order to discuss his work and experiences. The two met at length at least once, however, what happened at the meeting and thereafter is heavily disputed by the parties. Hughes states that he at least had implied permission to use Jacobsen's material. Hughes states that he sent an early version of Volume I to Jacobsen with a note stating that "I don't want to do anything you wouldn't feel good about, so let me know if anything is either wrong or somehow troubles you". Jacobsen responded to

this letter on March 21, 1999 with a note that stated in part that he had read the material and "looked forward to the finished product". Jacobsen now states that he never read the material and that the excerpts that he did glance at did not include any material from his memoir.

Hughes formally dedicated Volume II to Jacobsen and further encouraged Jacobsen to publish his memoir. Hughes states that he was not aware of Jacobsen's objections until sometime after Volume III had been published. Jacobsen argues that Hughes was aware of his objections much earlier. Jacobsen's attempts to publish his memoir were rejected and the memoir has never been published. Jacobsen alleges that the character of Wally in *Children of the Promise* is based upon him and that Hughes copied his original expression from *Who Refused to Die*. This action was filed in November of 1999, two months after Volume IV of Hughes' series was published.

II. Discussion

A. Motion to Dismiss: Defendants argue that this matter should be dismissed on the pleadings on the basis that Mr. Jacobsen's factual story can not be copyrighted. Copyright laws protect only "originality," which is both a statutory and a constitutional requirement for copyright protection. Thus, facts are not protected because "no one may claim originality as to facts." 1 M. Nimmer & D. Nimmer, *Copyright* § 2.11[A], p. 2-157 (1990).

Defendants rely heavily on *Feist Publications, Inc., v. Rural Telephone Service Co., Inc.*, 499 U.S. 340 (1991) and *Trans Western Pub. Co., v. Multimedia Marketing Assoc., Inc.*, 133 F.3d 773 (10th Cir.1998). In *Feist* the Court stated that: "If a compilation author clothes facts with an original collocation of words, he or she may be able to claim a copyright in this written expression. Others may copy the underlying facts from the publication but not the precise words used to present them". The

Court explained the difference between facts and copyrightable compilations as follows: "A compilation of facts or preexisting data is only protectable insofar as it features original selection, arrangement or coordination of facts as they appear in the work as a whole. *Feist* further states that "infringement must be shown by a substantial similarity of protectable expression, not just an overall similarity between the works". The Tenth Circuit takes this standard even further in *Trans Western*.

> The mere fact that a work is copyrighted does not mean that every element of the work may be protected. * * * Determining whether an infringement of a compilation copyright has occurred is particularly difficult where less than the entire work is copied * * * especially when a competitor can take "the bulk of the factual material from a preexisting compilation without infringement." The protection available for a compilation is "thin."

The Tenth Circuit goes on to set an even stricter standard for "thin" materials:

> Although a compilation gains copyright protection with only minimal creativity in the selection and arrangement of facts, Feist's statement that the copyright is "thin" has implications when the holder sues an alleged infringer. "It would seem to follow analytically that more similarity is required when less protectable matter is at issue. Thus, if substantial similarity is the normal measure required to demonstrate infringement, 'supersubstantial' similarity must pertain when dealing with "thin" works.

(citations omitted). Defendants argue that this is the standard that must be applied.

Jacobsen's Complaint alleges that Hughes copied "events, sequences of events, and characters." Defendants argue that events and sequences of events in Jacobsen's work are facts which cannot

be copyrighted. Defendants state that the assertion that Hughes copied characters is just another way of asserting that he copied facts. There are no original characters in Jacobsen's work and Hughes states that Wally is an original character not based upon Mr. Jacobsen at all. As far as copying distinctive words, the defendants argue that it is not clear what is meant by this. Hughes does not copy precise words of Jacobsen. He clearly sets part of his story in the factual setting of Jacobsen's memoir and occasionally uses individual phrases found in the manuscript, but they are not original nor distinctive. Words and phrases that are not original and are part of the factual context can not be copyrighted.

Defendants argue that the supersubstantial standard as set forth by the Tenth Circuit must apply in this matter and that the factual memoir of the plaintiff's is not protected material. The defendants further cite to *Narell v. Freeman,* 872 F.2d 907 (9th Cir.1989). In that matter the plaintiff had published a factual work about the history of Jews in San Francisco. The defendant published a fictional work about a Jewish family living in San Francisco and admitted consulting plaintiff's book during her research and taking language from it. The court dismissed the case holding that:

> * * * Although one may conclude that [defendant] appropriated [plaintiff's] historical research, the appropriation of expressive elements is minimal. The more numerous paraphrasing cited by [plaintiff] cannot be said to take the expressive elements of her work; instead unprotected factual details are taken, although in some cases commonly-used expressions are echoed. * * * [Defendant's] borrowings did not take a "sequence of creative expression," as opposed to an ordinary phrase, and therefore were not infringing.

Narell, which predates the Tenth Circuit's supersubstantial similarity test, is directly on point. *Narell* applies an extrinsic and intrinsic test. The extrinsic test determines whether the two works

are substantially similar in general ideas and compares the individual features of the works to find specific similarities between the plot, theme, dialogue, mood, setting, pace, characters and sequence of events. The intrinsic test is used to determine whether the forms of expression of the two works are substantially similar; it is subjective, depending on the response of an ordinary, reasonable reader. The *Narell* court discussed that when viewed as a whole, the works have slight resemblance to one another.

Plaintiff argues that Hughes' books are no more than a fictionalized account of Gene Jacobsen's memoir and that the substantially similar requirement has been met. Plaintiff first argues that *Feist* and *Trans Western* are distinguishable because they both deal with telephone directories which is not the same as the case at hand. Although this is certainly true, the language of these cases can be applied to the facts of this case. Plaintiff then argues that facts can be protected expression. The major case relied upon by the plaintiff is *Salinger v. Random House*, 811 F.2d 90 (2nd Cir.1987). In that case J.D. Salinger brought a copyright infringement action against the publisher of an unauthorized biography of Salinger and its author Ian Hamilton. Hamilton had copied published, copyrighted letters authored by Salinger. For example, Salinger expressed his unfavorable opinion of presidential candidate Wendell Willkie in a letter stating that: "He looks to me like a guy who makes his wife keep a scrapbook for him." Hamilton reported this by stating that Salinger "had fingered Willkie as the sort of fellow who makes his wife keep an album of his press cuttings." The court found that Hamilton copied original expression of Salinger and therefore infringed the copyrighted letters. The *Narell* court distinguishes *Salinger* as dealing with "highly original expressions".

The court has read the books at issue in this case,[1] including Mr. Jacobsen's memoir and all volumes of Mr. Hughes' *Children of the Promise* series. Having read the works at issue it is clear to this court that Mr. Hughes copied some "facts" from Mr. Jacobsen's memoir, but not significant original expression. The character of Wally is a complex character that is placed in various settings. Only a portion of his story takes place in the Phillippines and Japan. Further, Wally has a father who deems him a quitter and Wally has strayed somewhat from the Mormon religion. Much of the Children of the Promise series deals with spiritual matters and a most of the volumes are devoted to Wally's large and extended family. Jacobson's memoir, on the other hand, does not emphasize spiritual matters except in passing. There is little indication that Mr. Jacobsen is seen as a quitter by his father or anyone else. Further, the memoir deals only with Jacobsen's experiences in a limited matter and does not expand much over time and geography as do Hughes' novels. It is clear to this court that Wally is not Gene Jacobsen.

This case is analogous to *Narell v. Freeman,* 872 F.2d 907 (9th Cir.1989) in that Hughes appropriated historical research yet did not copy significant "original expression" from Jacobsen's memoir. This matter is distinguishable from *Salinger v. Random House*, 811 F.2d 90 (2nd Cir.1987) in that in *Salinger,* the defendant not only copied Salinger's telling of factual events, but copied much of Salinger's original and highly expressive commentary on the factual events. The fact that Salinger had an unfavorable opinion of Wendell Willkie for example, may have been a fact that could not be copyrighted; however, Mr. Salinger's comment that Willkie "looks to me like a guy who makes his wife keep a scrapbook for him" is a highly original expression and not

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[1] *Who Refused to Die* is part of the record before the court. *The Children of the Promise* series is referenced in the Complaint and therefore part of the record.

factual at all. In the case at hand Mr. Hughes has created fictional characters and placed one of them in a factual setting which is borrowed in part from Mr. Jacobsen's memoir. However, under the Tenth Circuit supersubstantial similarity test it is clear that Hughes did not copy any protectable aspects of the memoir. In reading the memoir it appears to this court that although it is a thoughtful work of courage, honor, discipline and perseverance, it is a historical work that is not protectable under the copyright laws.

B. Motion for Summary Judgment: Defendant Hughes has brought a Motion for Summary Judgment arguing laches, equitable estoppel and waiver. Waiver is a defense for the finder of fact and the facts in this matter are highly disputed; however the facts regarding laches and equitable estoppel are to be determined by the court. *See Mile High Industries v. Cohen,* 222 F.3d 845 (10th Cir.2000).

As stated, the court finds that Hughes did not utilize any protectable material from Jacobsen's memoir, however, even assuming that the memoir does contain protectable material, Jacobsen is barred under the doctrine of laches from pursuing a claim. The Tenth Circuit has held that the defense of laches consists of two elements: (1) inexcusable delay by plaintiff in instituting suit; and (2) such delay results in prejudice to the defendant. *See Brunswick Corp. v. Spinit Reel Co.,* 832 F.2d 513, 523 (10th Cir.1987). The record before this court demonstrates that Jacobsen had knowledge of the material used by Hughes as early as 1994 and no later than 1996. Hughes sent excerpts from Volume I to Jacobsen in March of 1996 with the letter stating "I don't want to do anything you wouldn't feel good about, so let me know if anything is either wrong or somehow troubles you." Hughes interviewed Jacobsen more than once with the first interview being in 1994 and Jacobsen responded to Hughes' 1996 letter with a letter that stated he had read the material and looked forward to the finished product. Jacobsen did not express any disapproval of *The Children of the Promise* series until 1999,

after Volume III had been published. Had Jacobsen voiced his disapproval in 1996 Hughes would have had the opportunity to take the offending material out of the books. For Jacobsen to wait until three volumes of the series had been published before voicing his disapproval, when it is clear he had ample opportunity to let Hughes know of his disapproval as early as 1996 results in extreme prejudice to Hughes. Hughes could have produced his series without relying upon Jacobsen's manuscript and then would not have been placed in the position he now finds himself. Jacobsen's delay in informing Hughes about his disapproval bars Jacobsen's recovery under the doctrine of laches.

The evidence before this court at this time does not support granting summary judgment on the affirmative defense of estoppel. The distinction between the affirmative defenses of laches and estoppel is that laches turns on whether plaintiff has unjustifiably delayed enforcing his rights. Estoppel turns on whether plaintiff has induced the offending conduct. Although it appears that it is possible that the March 12, 1996 letter stating that Jacobsen was looking forward to the finished product, may have influenced Mr. Hughes decision to continue with the now offensive plot line, based upon the evidence before the court at this time it does not seem clear that Jacobsen's conduct induced Hughes to rely upon *Who Refused to Die.* Rather, it was Jacobsen's failure to inform Hughes that he disapproved of the use of his work that lead to the situation at hand. Therefore, defendant's Motion for Summary Judgment on the grounds of estoppel is denied.

Lastly, defendant's Motion to Strike Jacobsen's factual assertions in his Opposition to the Motion for Summary Judgment is denied. The court is capable of reading the factual assertions and determining what material is relevant and admissible and what is not. It is unnecessary to strike Jacobsen's factual assertions.

For the reasons stated herein, it is hereby

ORDERED that Defendants' Motion to Dismiss is **GRANTED**. Defendant Hughes' Motion for Summary Judgment is **GRANTED** as to the affirmative defense of laches and **DENIED** as to the affirmative defenses of waiver and equitable estoppel. Defendant Hughes' Motion to Strike is **DENIED** and Defendants' Motion for attorney's fees is also **DENIED**. Each party is to bear its own costs.

DATED this 11th day of January, 2001.

/s/

DALE A. KIMBALL
United States District Judge